REMARKS

Applicant expresses appreciation to the Examiner for consideration of the subject patent application. This amendment is in response to the Advisory Action mailed September 7, 2005. Claims 1, 3-11 and 13-23 were rejected in the Final Office Action.

Claims 1-23 were originally presented. Claims 2 and 12 were previously canceled. Claims 1, 3-11, and 13-23 remain in the application. Claim 24 was added.

Claim Rejections - 35 U.S.C. § 103

Claims 1, 3-11, and 13-15 (including independent claims 1 and 11) were rejected under 35 U.S.C. § 103 as being unpatentable over Knight et al. (U.S. 6,493,703) (hereinafter "Knight") in view of Tso (U.S. 6,742,047) (hereinafter "Tso") and further in view of Williams (US 2001/0054029).

The Knight, Tso, and Williams references, when combined, do not teach or suggest another element of claim 1. Specifically, the Tso and Williams references do not teach the **limitation of associating a plurality of resources with the keywords, wherein the resources refer to digital objects,** and the Knight reference does not overcome that deficiency.

The Knight reference discloses an online message board system configured to monitor message traffic generated by subscribers. (See Knight Abstract) Software robots are used to locate, retrieve, and sort content derived from other news groups. The content consists of relevant text messages posted by users on the news groups. (Col. 5 Line 49 to Col 6 Line 13). A content collection system can take into account community based and user queries. (Col. 19, Lines 33-57). Data extraction filters generated as a result of monitoring subscriber queries and postings are used to identify new subject matter of general interest to an online community. (Col 19, Line 58 – Col 20, Line 30). A numerical ranking or index can be built of subjects that are of interest to the community. Content (i.e. electronic messages) can be extracted from other news groups.

Knight does not disclose linking keywords with digital objects. The Advisory Action states that Knight only teaches that keywords are associated with content from newsgroups. More specifically, the electronic messages which are extracted from other newsgroups are simply

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textual. There is no teaching or suggestion in Knight concerning the use of linking key words to digital objects. However, the Examiner has averred that the definition of digital object is not clear, as used in claim 1.

The Court of Appeals for the Federal Circuit recently decided, en banc, that "the claims, of course, do not stand alone. Rather, they are part of 'a fully integrated written instrument,' Markman, 52 F.3d at 978, consisting principally of a specification that concludes with the claims. For that reason, claims 'must be read in view of the specification, of which they are a part.' " Phillips v. AWH Corp., 415 F.3d 1303, 1315 (Fed. Cir. 2005.) The close kinship between the written description and the claims is enforced by the statutory requirement that the specification describe the claimed invention in "full, clear, concise, and exact terms." 35 U.S.C. § 112, para. 1; id. at 1316. The descriptive part of the specification aids in ascertaining the scope and meaning of the claims inasmuch as the words of the claims must be based on the description. The specification is, thus, the primary basis for construing the claims. Id. at 1315.

Digital objects are defined in the specification to include web pages, executable scripts, graphic objects, sounds, video, documents, animations, executable objects, and similar objects which may be sent to a user from a web site. (See Yu Specification, Page 8 Line 23 – Page 9 Line 1).

Applicant respectfully submits the term digital object, as used in independent claim 1 and defined within the specification, is not taught or suggested in Knight, nor a combination of the cited prior art references. Therefore, Applicant believes that independent claim 1 is allowable, and urges the Examiner to withdraw the rejection.

Rejection of the dependent claims 3-11 and 13-15 should be reconsidered and withdrawn for at least the reasons given above with respect to the independent claim. The dependent claims, being narrower in scope, are allowable for at least the reasons for which the independent claim is allowable.

Claims 16-18 and 20-23 (including independent claims 16, 20, 22, and 23) were rejected under 35 U.S.C. § 103 as being unpatentable over Knight in view of Tso.

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·As discussed in the previous response, the concept claimed in claim 16 is different from that claimed in claim 1. Claim 16 is for a method for personalizing digital objects and content associated with electronic search results. A generic search using a general search engine returns results based on keywords a user enters. However, using the present invention, a search engine can be enhanced to deliver community based prioritized search results by modifying the generic search results using terms that are relevant to specific communities of users. (See Yu Specification, Page 18, Line 24 – Page 19, Line 22).

Claim 16 is a method for personalizing digital objects and content associated with electronic search results for users who belong to an aggregate community. The claim reads, in part:

organizing a plurality of search contexts **that maps at least one keyword to each search context;...**

delivering search results to the users based on the aggregate community's activities for resources that were previously accessed.

The Office Action states that Knight does not disclose that search contexts are accessed that include a plurality of keywords associated with them. However, the Office Action asserts that Tso discloses a method in which keywords are "obtained from a list of categories that have keywords associated with them."

Even if the structures of the Knight and Tso references are combined as proposed by the Examiner, the result would necessarily constitute a structure different from that of the Applicant's, and one that would not accomplish the result of claim 16. Tso discloses that *predetermined* selection criteria, such as keywords, may be *defined* by individual users or system administrators on a persistent basis. (See Tso, Col. 2, Lines 29-33). Web content is then searched for those predetermined keywords. The web content can then be dynamically altered by removing the keywords from the web content.

In contrast, the method of organizing a plurality of search contexts that maps at least one keyword to each search context is not solely dependent upon predetermined criteria defined by a user or system administrator. Rather, the searches are organized based upon the aggregate

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communities' activities. For example, in one embodiment each time a user of a community clicks on an item returned in a search result, an interest count can be registered for that community, the search item, and the search context. The search context can be developed using complicated algorithms such as sophisticated Bayesian net or other artificial intelligence techniques that map input keywords onto the search contexts.

Combining the structures of Knight and Tso would result in an online message board system in which *predetermined* keywords were *defined* by individual users or system administrators. The defined keywords could then be filtered from content perused by users of the online message board system disclosed in Knight. This combination constitutes a structure and method substantially different from that of the Applicant's in claim 16. The result of claim 16 could not be accomplished using the combination of Knight and Tso.

Neither Knight nor Tso teaches or suggests the concept of delivering search results to the users based on the aggregate community's activities. The Examiner is relying upon hindsight, having knowledge of the Applicant's own structure. But for this knowledge, the combination of the Knight and Tso references would not have occurred to the Examiner, as it did not occur to those skilled in the art to make the asserted combination.

Therefore, Applicant respectfully submits that independent claim 16 is allowable, and urges the Examiner to withdraw the rejection.

Rejection of the dependent claims 17-19 should be reconsidered and withdrawn for at least the reasons given above with respect to the independent claim. The dependent claims, being narrower in scope, are allowable for at least the reasons for which the independent claim is allowable.

Independent claim 20 includes the delivery of news based on aggregate activity. The Knight and Tso references, when combined, do not teach or suggest all of the elements of claim 20. Specifically, the Knight reference does not teach associating a plurality of digital objects with keywords, and delivering news based on activity with those keywords. The Tso reference does not overcome that deficiency.

Claim 20 reads, in part:

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accessing categories that include a plurality of keywords associated
with the categories;

associating a plurality of resources with the keywords, wherein the
resources refer to digital objects;

The combination of the Knight and Tso references would necessarily constitute a structure different from that of the Applicant's, and one that would not accomplish the result of claim 20. Unlike the online message board system disclosed in the Knight invention, which is only concerned with text based messages, the present invention pertains to a variety of digital objects. As previously stated, digital objects are defined as web pages, executable scripts, graphic objects, sounds, video, documents, animations, executable objects, and similar objects which may be sent to a user from a web site. (See Yu Specification, Page 8, Line 23 – Page 9, Line 1).

The present invention can be used to personalize a web page based on user and community interests. When a personalization system has determined a user's content preferences, digital objects associated with a web page are delivered to users based on the user's content preferences across multiple categories. (Page 12, Lines 14-16). Thus, rather than being merely a text based service, as in Knight, the present invention includes personalized web pages full of a variety of different types of digital objects.

Tso discloses that *predetermined* selection criteria, such as keywords, may be *defined* by individual users or system administrators on a persistent basis. (See Tso, Col. 2, Lines 29-33). Web content is then searched for those predetermined keywords. The web content can then be dynamically altered by removing the keywords from the web content. Tso does not teach or suggest associating a plurality of digital objects with keywords.

As previously stated, combining the structures of Knight and Tso would result in an online message board system in which *predetermined* keywords were *defined* by individual users or system administrators. The defined keywords could then be filtered from content perused by users of the online message board system disclosed in Knight. This combination constitutes a structure substantially different from that of the Applicant's in claim 20. The result of claim 20 could not be accomplished using the combination of Knight and Tso.

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Therefore, Applicant respectfully submits that claim 20 is allowable, and urges the Examiner to withdraw the rejection.

Rejection of the dependent claim 21 should be reconsidered and withdrawn for at least the reasons given above with respect to the independent claim. The dependent claim, being narrower in scope, is allowable for at least the reasons for which the independent claim is allowable.

Independent claim 22 is for a method for delivering personalized digital objects and shopping items associated with electronic shopping to users who belong to an aggregate shopping community. The specification discloses an example embodiment wherein people can join various communities such as "high fashion", "conservative", "teen", etc. A count can then be kept for items that are purchased by the various groups of users. As the count matures, the community shopping mall can promote the items most popular to the relevant communities, based on the membership of each user. (See Yu Specification, Page 21, Lines 5-25).

Claim 22 reads, in part:

associating a user with an aggregate shopping community;

associating a plurality of resources with the digital objects and

shopping items;...

delivering a shopping promotion to users based on the aggregate

shopping community's activities.

In contrast, neither the Knight reference nor the Tso reference discloses associating a user with an aggregate shopping community. Nor do the cited references teach or suggest associating a plurality of resources with the digital objects and shopping items. Indeed, shopping is not mentioned in either reference. Thus, neither reference teaches or discloses delivering a shopping promotion to users based on the aggregate shopping communities activities. The ability to deliver promotions based on the communities activities can be a tremendous boon for advertisers.

Therefore, Applicant respectfully submits that claim 22 is allowable, and urges the Examiner to withdraw the rejection.

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The same arguments made for independent claim 1 apply for independent claim 23. Applicant respectfully submits that claim 23 is allowable, and urges the Examiner to withdraw the rejection.
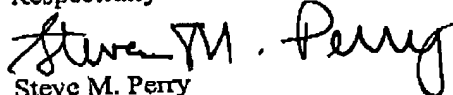
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CONCLUSION

In light of the above, Applicant respectfully submits that pending claims 1, 3-11, and 13-24 are now in condition for allowance. Therefore, Applicant requests that the rejections and objections be withdrawn, and that the claims be allowed and passed to issue. If any impediment to the allowance of these claims remains after entry of this Amendment, the Examiner is strongly encouraged to call Steve Perry at (801) 566-6633 so that such matters may be resolved as expeditiously as possible.

Dependent claims 2 and 12 were previously canceled. Dependent claim 24 was added. Therefore, no additional fee is due.

The Commissioner is hereby authorized to charge any additional fee or to credit any overpayment in connection with this Amendment to Deposit Account No. 08-2025.

DATED this 19th day of September, 2005.

Respectfully submitted,

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